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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/774,490	01/31/2001	Shengfang Jin	07334-138001	3043

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EXAMINER

CANELLA, KAREN A

ART UNIT	PAPER NUMBER
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1642

12

DATE MAILED: 04/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/774,490

Applicant(s)
Jin

Examiner
Karen Canella

Art Unit
1642



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 30 days MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-27 is/are pending in the application.
- 4a) Of the above, claim(s) 5-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 23-27 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

1. Claims 1-4 have been canceled. Claims 23-27 have been added. Claims 5-27 are pending. Claims 5-22, drawn to non-elected inventions, remain withdrawn from consideration. Claims 23-27 are under consideration.

Election/Restriction

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 23 to 27 in part, drawn to methods of determining whether a test compound is a candidate compound for modulating the drug resistance of a eukaryotic cell, the method reliant upon the determination of Semaphorin D (GenBank Accession Number X85993 (SEQ ID NO:1)), classified in class 435, subclass 6.
- II. Claims 23 to 27 in part, drawn to methods of determining whether a test compound is a candidate compound for modulating the drug resistance of a eukaryotic cell, the method reliant upon the determination of Semaphorin III (GenBank Accession Number L26081), classified in class 435, subclass 6.
- III. Claims 23-27 in part, drawn to methods of determining whether a test compound is a candidate compound for modulating the drug resistance of a eukaryotic cell, the method reliant upon the determination of B94 (GenBank Accession Numbers L24118 and M92357), classified in class 435, subclass 6.
- IV. Claims 23-27 in part, drawn to methods of determining whether a test compound is a candidate compound for modulating the drug resistance of a eukaryotic cell, the method reliant upon the determination of mel-14 (GenBank Accession Number M25324 (SEQ ID NO:2) and GenBank Accession Number M25280) classified in class 435, subclass 6.
- V. Claims 23-27 in part, drawn to methods of determining whether a test compound is a candidate compound for modulating the drug resistance of a eukaryotic cell,

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the method reliant upon the determination of 24p3 (GenBank Accession Number W13166 (SEQ ID NO:3) or GenBank Accession Number X81627 (SEQ ID NO:4)), classified in class 435 subclasses 6 and 7.1 .

VI. Claims 23-27 in part, drawn to methods of determining whether a test compound is a candidate compound for modulating the drug resistance of a eukaryotic cell, the method reliant upon the determination of Proliferin (GenBank Accession Number K03235), classified in class 435, subclass 6.

VII. Claims 23-27 in part, drawn to methods of determining whether a test compound is a candidate compound for modulating the drug resistance of a eukaryotic cell, the method reliant upon the determination of Maspin (GenBank Accession Number U54705 (SEQ ID NO:5) and GenBank Accession Number U04313 (SEQ ID NO:6)), classified in class 435, subclass 6.

3. The inventions are distinct, each from the other because of the following reasons:

The methods of Groups I-VII differ in the detection of different gene products which differ both structurally and functionally. The examination of all groups would require different searches in the U.S. Patent Shoes and the scientific literature and would require the consideration of different patentability issues.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their recognized divergent subject matter and different classification and because the searches required for the groups are not co-extensive, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

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Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

4. In the event that applicant elects Group III, the following Election of species is required:

This application contains claims directed to the following patentably distinct species of the claimed invention: L24118 and M92357.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 23-27 are generic.

5. In the event that applicant elects Group IV, the following Election of species is required:

This application contains claims directed to the following patentably distinct species of the claimed invention: M25324 (SEQ ID NO:2) and M25280.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 23-27 are generic.

6. In the event that applicant elects Group V, the following Election of species is required:

This application contains claims directed to the following patentably distinct species of the claimed invention: W13166 (SEQ ID NO:3) and X81627 (SEQ ID NO:4).

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 23-27 are generic.

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7. In the event that applicant elects Group VII, the following Election of species is required:

This application contains claims directed to the following patentably distinct species of the claimed invention: U54705 (SEQ ID NO:5) and U04313 (SEQ ID NO:6).

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 23-27 are generic.

8. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen Canella whose telephone number is (703) 308-8362. The examiner can normally be reached on Monday through Friday from 8:30 am to 6:00 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, can be reached on (703) 308-3995.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

A handwritten signature in cursive script, reading "Karen A. Canella", followed by a horizontal line.

Karen A. Canella, Ph.D.

Patent Examiner, Group 1642

April 9, 2003